IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	10/015,816	**Group Art Unit:**	2173
Applicants:	Thomas J. SHAFRON, et al.	**Examiner:**	Michael Roswell
Filing Date:	November 1, 2001	**Docket No.**	085804.014301
Title: Method and System of Facilitating On-Line Shopping Using an Internet Browser		**Customer No.**	76058

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

In response to the Examiner's Answer dated November 16, 2007, pursuant to the Appeal Brief filed in the above-identified application on August 10, 2007, and in accordance with 37 C.F.R. § 41.41, Appellants respectfully submit the following Reply Brief. This Reply Brief is being filed within two months of the date of the Examiner's Answer and is therefore believed to be timely. 37 C.F.R. § 41.41(a)(1).

The following items are set forth as prescribed in MPEP § 1208.

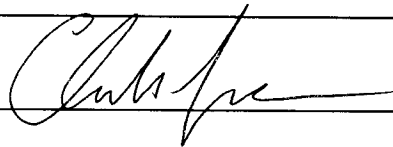### Certificate of Electronic Mailing (37 C.F.R. § 1.8)

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STATUS OF CLAIMS

Claims 1-24, 59 and 60 are pending in the application. In the final Office Action dated November 8, 2006, claims 1-24, 59 and 60 were rejected. Claims 1-24, 59 and 60 remain under final rejection and are the subject of this appeal.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-14, 16-21, 23, 24, 59 and 60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Leary et al. (U.S. Pat. Application Publication No. 2002/0077978) and further in view of Sidles (U.S. Pat. Application Publication No. 2002/0062342) and Wiens et al. (U.S. Pat. No. 5,808,894).

2. Claims 15 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Leary et al., Sidles and Wiens et al., and further in view of "Band Objects" (Microsoft).

In the Examiner's Answer, the Examiner has restated the grounds of rejection by repeating verbatim the rejection in the final Office Action dated November 8, 2006. No new ground of rejection has been set forth.

ARGUMENT

Introduction

In the Examiner's Answer, the Examiner has confirmed that applicants' statements in the Appeal Brief under 37 C.F.R. § 41.37(c)(1)(i) through (c)(1)(vi) are correct. The Examiner has also confirmed that the copy of the appealed claims submitted under 37 C.F.R. § 41.37(c)(1)(viii) is correct.

The Examiner's comments in the Response to Arguments section of the Examiner's Answer (pages 14-16) have been carefully reviewed. As understood by the applicants, the Examiner's contentions may be stated briefly as follows:

(1) The term "supported merchant web site" appearing in the claims is not precisely defined in the cited portion of the specification.

(2) The Sidles reference (U.S. Pat. Application Publication No. 2002/0062342), particularly at paragraphs 20 and 55, teaches "determination code" to determine if a merchant web site is a supported merchant web site.

(3) The Wiens et al. reference (U.S. Pat. No. 5,808,894) teaches similar determination code for determining whether a web site is a supported merchant web site.

(4) A user of the system of Wiens et al. would want to include the determination code of Sidles, so that the merchant web site could be verified and/or authenticated.

(5) The O'Leary et al. reference (U.S. Pat. Application Publication No. 2002/0077978) describes a wallet function (paragraph 52) launched by the user, which may be accessed through a toolbar button or an icon. With regard to claim 60 (Appeal Brief, page 19, last paragraph) the applicants submit that the appearance of the wallet icon in O'Leary et al. does not indicate on the toolbar button whether the merchant web site is a supported web site as required by the claim; the Examiner disagrees.

The applicants' response to each of these contentions appears below.

<u>(1) The claim term "supported merchant web site"</u>

A. The term "supported merchant web site" has a clear meaning in light of the specification

1. The term "supported merchant web site" refers to on-line shopping

The term "supported merchant web site" is used in numerous places in the specification. References to the specification are provided as examples and for convenience, and are not intended and should not interpreted to necessarily be a complete recitation of all instances in the specification relevant to a claim element corresponding to such reference. Similarly, references to the specification do not imply that the portions referenced necessarily fall within or without of the scope of any claim element corresponding to such reference.

At the first mention of "supported merchant web site" in the specification (page 10, lines 11-22), it is made clear that a shopping assistant button and shopping assistant functionality are supported when the user visits a supported merchant web site.

2. Application of "supported merchant web site" to shopping functionality

In the discussion of on-line shopping using an embodiment of the invention (e.g., page 49, line 3, to page 50, line 10), it is also made clear how the shopping assistant functionality applies to a supported merchant web site. Furthermore, in a discussion of an embodiment of the invention, it is explicitly described how it may be determined whether a merchant web site is a supported web site (e.g., page 51, lines 11-21).

A supported merchant web site is also described in the specification at page 54, lines 11-21, in connection with a visit by a shopper to a merchant web site, and further with regard to the process of determining whether the web address visited by the shopper is indeed a supported merchant web site.

3. Nothing in the record suggests that the term "supported merchant web site" is unclear, or lacks proper support in the specification

The Examiner has not previously raised any objection to the term "supported merchant web site," and has not alleged that this term lacks support in the specification. It is noted that the Examiner has made no rejection of the claims under 35 U.S.C. § 112 relating to the term

"supported merchant web site." Accordingly, it remains only to interpret this term properly in light of the specification. MPEP § 2111.

B. Interpretation of the term "supported merchant web site"

1. Claim terms must be consistent with an interpretation as by one skilled in the art

It is well settled that during examination, claim terms are given their broadest reasonable interpretation. To be "reasonable," such interpretation must be consistent with one which would be reached by a person skilled in the art. See In re Buszard, 504 F.3d 1364 (Fed. Cir. 2007). Claims "are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Bond, 910 F.2d 831, 833 (Fed. Cir. 1990)(emphasis added).

2. Reasonable interpretation of "supported merchant web site"

It is submitted that one skilled in the art would understand from the specification (at least from page 51, lines 11-21, and other places) that a "supported" merchant web site is to be understood as a merchant web site at which the downloaded shopping assistant functionality for online shopping is available to a user who navigates to that web site. Furthermore, in the embodiment discussed in the specification at page 51, lines 11-16, code for determining if a merchant web site is a supported web site is explicitly described.

(2) Sidles does not disclose or suggest code to determine if a web site is a supported merchant web site, as required by the claims

A. Sidles fails to teach communicating determination code to determine if a merchant web site is a supported merchant web site, or determining at a shopper's computer if a web site is a supported merchant web site

The Examiner's Answer (page 4, lines 10-11), with regard to independent claims 1 and 18, states that Sidles fails to teach communicating determination code for determining if a merchant web site is a supported web site.

The Examiner's Answer (page 11, lines 18-19), with regard to independent claim 21, also states that Sidles fails to teach determining at the computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site. It is noted that this feature is likewise recited in independent claim 60.

The applicants submit that Sidles also fails to teach or suggest a step, as recited in independent claim 12, of determining if a web site to which the Internet browser is caused to navigate is a supported merchant web site, for reasons further detailed below.

B. Site verification in Sidles

Sidles is concerned with an intelligent system for filling in merchant-supplied forms, where a form is downloaded from a merchant web site (paragraph 55). A form fill system retrieves the user's personal information from a database and proceeds to complete the form. Sidles teaches that this process is undertaken only after validating the identity of the web site (paragraph 20) or verifying the authenticity of the web site (paragraph 55).

C. Verification of a site does not establish whether the site is supported, as required by the claims

The system of Sidles is directed to filling out a form with a user's personal information. Sidles is thus concerned with verifying that a user is who he purports to be and that the merchant is who it purports to be (see paragraph 20). Sidles does not investigate any properties of the web site before handling a request to download a form and beginning to fill out the form (paragraph 54). In particular, Sidles makes no inquiry whether any particular functionality (let alone shopping assistant functionality) is supported at a given site. Indeed, Sidles attempts to fill out forms from sites never previously encountered (paragraph 35), the opposite functionality of determining if a merchant's site is a supported merchant site. Verification or authentication, as taught by Sidles, is in no way a determination, or a communication of determination code configured to determine, if a merchant web site is a supported merchant web site, as claimed.

The applicants therefore maintain that Sidles does not disclose or suggest determining if a merchant web site is a supported web site, as required by claim 12. Furthermore, as noted above, the record indicates that Sidles does not teach communicating determination code for

7   U.S. Application No. 10/015,816

determining if a merchant web site is a supported web site, as required by claims 1 and 18; or determining at the computer if a web site to which the Internet browser is caused to navigate is a supported merchant web site, as required by claims 21 and 60.

(3) Wiens et al. does not disclose or suggest determining, or communicating code to determine, if a web site is a supported merchant web site, as required by the claims

A. Vendor information files in Wiens et al.

Wiens et al. (col. 7, lines 28-47, and Figure 2, step 40) discloses a process in which a vendor information file is downloaded from a vendor computer to a user if the version stored at the user's computer is not the current version. There is no disclosure in Wiens et al. that the vendor computer is a web site, much less a merchant web site at which online shopping may be conducted. The vendor information file contains product information and/or advertising and is provided as a convenience for the user when the user composes a purchase order off-line (col. 6, line 66, to col. 7, line 4). Whether a new version of the vendor information file is downloaded essentially depends on how recently the user was last connected to the vendor computer. It is noteworthy that this process is preferably performed after an order is taken and confirmed (col. 7, lines 23-24).

B. The version updating in Wiens et al. is not related to determining whether a web site is a supported merchant web site

Wiens et al. suggests (col. 7, lines 29-32) code for comparing the user's version of a vendor information file with the current version downloadable from the vendor computer. This version-checking code does not determine whether any functionality is available to the user when the user is connected to the vendor computer. Any vendor information file downloaded to the user computer is intended only to provide information to a customer for his off-line use, and has no function for determining whether a web site the user is connecting to is a supported merchant web site. This process is in no way equivalent to determining whether a merchant web site is a supported web site. In the shopping environment envisioned by Wiens et al., the capabilities of the vendor computer with which the user is connected are already well known to

U.S. Application No. 10/015,816

085804.014301

the user before the process disclosed in Wiens et al. is carried out; no determination is desired or performed by the Wiens et al. system, and no communication of such determination code can be taught by Wiens et al.

Regardless whether a transaction using the Wiens et al. system is genuinely "on-line shopping," the downloaded version-checking code cannot be characterized as determining whether a merchant web site is supported; before this code is executed, the user has already interacted with the vendor computer and placed an order. Stated another way, the process for providing "pertinent vendor information" generally is not initiated until after the question of a "supported merchant web site" becomes moot.

Wiens et al. thus does not teach or suggest determining, much less communicating determination code to determine, if a merchant web site is a supported merchant web site, as required by the claims.

(4) A combination of Sidles and Wiens et al. still does not suggest code to determine if a web site is a supported merchant web site, as required by the claims

A. Wiens et al. does not remedy the defects of Sidles with respect to the required claim feature regarding a supported merchant web site

As discussed above, the "verifying" process of Sidles is in no way equivalent to determining if a merchant web site is a supported web site. Furthermore, in Wiens et al., vendor information files are updated and provided to a user, but there is no determination if a merchant web site is supported. A user of the system of Wiens et al. has already selected the merchant, is interacting with the vendor's computer, and has already placed an order, so no inquiry regarding support for the vendor computer is needed.

B. Wiens et al. does not suggest determining whether a merchant is supported

It is noted that according to Wiens et al., a user communicates with a particular vendor computer (col. 4, lines 25-30). Wiens et al. does not envision visiting different merchant web sites, and thus does not address in any way the issue of determining whether a web site is

9   U.S. Application No. 10/015,816

085804.014301

supported. A user of the system of Wiens et al. composes an order off-line and then connects to a preselected vendor computer whose identity and functionality are already known (see Wiens et al., col. 4, lines 45-49, and Figure 1A). Accordingly, this does not involve determining if a merchant web site is a supported web site.

(5) O'Leary et al. does not teach or suggest a shopping assistant button on a browser toolbar providing an indicator when the Internet browser is caused to navigate to a supported web site, as required by claims 9, 16, 23 and 60

A. Defects of O'Leary et al. as a reference against the claims

The Office Action dated November 8, 2006 states that O'Leary et al. fails to teach determining (or communicating code for determining) if a web site is a supported merchant web site, as required by the respective independent claims (page 3, lines 10-11 with regard to claims 1 and 18; page 10, lines 2-5 and 18-19 with regard to claims 12 and 21; page 8, lines 9-10, with regard to claim 60).

B. O'Leary et al. does not teach or suggest the claimed indicator provided by the toolbar button

The applicants have not found any teaching or suggestion that a shopping assistant button, added to a toolbar, provides an indicator when the browser is caused to navigate to a supported merchant web site, as required by claims 9, 16, 23 and 60. Claims 9, 16, 23 and 60 describe a change in state of the shopping assistant button when the Internet browser is caused to navigate to a supported merchant web site (see specification, page 56, lines 5-12, and Figure 11). The record is devoid of any such indicator being provided on a shopping assistant button of a toolbar. The only reference referred to with respect to this claim limitation is O'Leary et al. According to O'Leary et al., a user visiting a merchant web site may invoke wallet functions by clicking on a wallet button on the toolbar (paragraph 81). O'Leary et al. offers no teaching or suggestion regarding any indicator relating to a toolbar button. O'Leary et al. is completely silent regarding an indication on the toolbar that the merchant web site is a supported web site.

U.S. Application No. 10/015,816

Even if, as suggested by O'Leary et al. (paragraph 81), an icon is embedded into a merchant web page, this in no way provides a teaching or suggestion regarding an indicator further provided by a shopping assistant button on a toolbar when the Internet browser is caused to navigate to a supported merchant web site, as required by the claims.

Accordingly, it is submitted that claims 9, 16, 23 and 60 would not have been obvious from any of the cited references, or from any combination thereof, as the references, singly or in combination, are missing the claimed indicator element.

Conclusion

The applicants respectfully maintain that a prima facie case of obviousness has not been established for any of the rejected claims, for the reasons set forth in the Appeal Brief and in the present Reply Brief. All of claims 1-24, 59 and 60 are therefore believed to be in condition for allowance.

The applicants' undersigned attorney may be reached by telephone at 212-801-6729. All correspondence should continue to be directed to the address listed below, which is the address associated with Customer Number 76058.

Respectfully submitted,

Date: January 16, 2008

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